



UNITED STATES PATENT AND TRADEMARK OFFICE

clu
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,368	10/26/2001	James P. Hoeffler	INVIT1100-2	2504

28213 7590 06/27/2006

DLA PIPER RUDNICK GRAY CARY US, LLP
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

EXAMINER

COOK, LISA V

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Amendment Entry

1. Applicant's amendment filed 4/6/06 is acknowledged. In the amendment filed therein claims 19, 20, 51-60, 62, 63 and 65-67 were canceled without prejudice. While claims 18 and 24 were modified (amended). New claims 71-87 have been added. Currently claims 18, 21-24, 48-50, 61, 64, 68-87 are pending and under consideration.
2. Applicant's newly submitted claims have necessitated the following Species Election. Examiner apologizes for any inconvenience this may cause Applicant.

ELECTION OF SPECIES

3. This application contains claims directed to the following patentably distinct species of the claimed invention: The claims are directed to a method of comparing protein expression in at least two cell populations via multiple antibody utility (see claims 18, 21-24, 48-50, 61, 64, 68-87). However the method includes a plurality of patentably distinct inventions wherein materially different substances/antibodies are employed. Each substance/antibody acts as a ***binding agent*** to produce protein-binding patterns in the claimed method but are diverse compositions having independent characteristics, which are not totally encompassed by all antibodies. Accordingly the substances/antibodies act independently and distinctly in the method. The claims are drawn to different antibody characteristics/ diverse substances. Therein applicant is required to select one for consideration.

As to *group I*: claims 18, 21-24, 48-50, 61, 64, 68-70, 83, and 85-87 are drawn to a method of comparing protein expression in two or more populations of cells via *uncharacterized* antibodies or antibodies with unknown specificity.

Art Unit: 1641

As to *group II*: claims 18, 71-82 and 84 are drawn to a method of comparing protein expression in two or more populations of cells via *a collection of antibodies (multiple and different) having recognized binding for different antigen(s)*.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claim 18 is generic.

5. Applicant is advise that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1641

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 – Central Fax number is (571) 273-8300, which is able to receive transmissions 24 hours/day, 7 days/week. In the event Applicant would like to fax an unofficial communication, the Examiner should be contacted for the appropriate Right Fax number.

Art Unit: 1641

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (571) 272-0816. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (571) 272-0823.

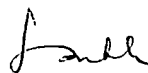
Any inquiry of a general nature or relating to the status of this application should be directed to Group TC 1600 whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lisa V. Cook
Patent Examiner
Art Unit 1641
Remsen 3C-59
571-272-0816
6/16/06



LONG V. LE 06/21/06
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600